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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,909	09/30/2003	George Duncan Pearson	1021-005US02	2080
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Shumaker & Sieffert, P.A. 1625 Radio Drive, Suite 300 Woodbury, MN 55125			EXAMINER SAINDON, WILLIAM V	
			ART UNIT 3623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,909	<b>Applicant(s)</b> PEARSON ET AL.	
	<b>Examiner</b> WILLIAM V. SAINDON	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/2/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following FINAL Office Action is in response to applicant's submission received December 2, 2008. Claims 7-10, 12, and 13 were amended. Claims 1-6 and 14-21 were canceled. No claims were added. Therefore, claims 7-10, 12, and 13 are pending.

#### ***Response to Amendment***

2. The 35 USC § **101 rejection of claims 7-10, 12, and 13 is not withdrawn** in light of applicant's amendment. The amendment does not cure the deficiencies, as noted in the § 101 rejection below.

3. The 35 USC § **103 rejection** of claims 7-10, 12, and 13 as unpatentable over Elkin et al. (US 2007/0179828) in view of official notice is **not withdrawn** in light of applicant's amendments. Please refer to the updated § 103 rejection below, which addresses the newly added subject matter.

#### ***Response to Arguments***

4. The 35 USC § **112 ¶ 1 rejection of claims 10, 12, and 13 is not withdrawn** in light of applicant's arguments.

Applicant argues that a written description of "reconciling" can be found at ¶¶ 51-52. These paragraphs, however, do not provide a sufficient written description to convey possession of an invention that "reconciles." At ¶ 51, "users ... are given the opportunity to reconcile." This does not describe the claimed method of reconciling. At

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¶ 52, "servers 26 may be used to reconcile," "authentication servers 44 may 'push' reconciliation jobs," "the remote computing devices reconcile the contribution data," and so forth. None of these sections actually describe "reconciliation." Instead they just happen to mention the word. "Reconciliation" could mean anything, and one of ordinary skill in the art would not be conveyed of any form of "reconciliation."

Because "reconcile" is not a concept referring to some definite, well-known process, some instruction is expected to provide support of a method that reconciles. The mere naming of a function does not convey possession of that function. Evidence of the possession of that function is required. Without evidence of an actual process of reconciling (such as steps or a flowchart), one of ordinary skill in the art would not believe applicant was in possession of such an invention.

5. The 35 USC § **112 ¶ 2 rejection of claims 10, 12, and 13 is not withdrawn** in light of applicant's arguments.

Applicant argues that "reconciling" is clear, however the specification provides no special definition or other guidance as to what the process of "reconciling" entails. Applicant cites ¶¶ 31 and 52, but neither of these paragraphs define reconciliation or describe what reconciliation is. Paragraph 32 does not define reconciliation or describe what reconciliation is. Instead, it uses the word "reconciliation" in a sentence without any meaningful description of what reconciliation is. Not only does the claim not provide meaning to the term "reconciling," but the specification is equally deficient in describing the term.

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6. The 35 USC § **103 rejection** of claims 7-10, 12, and 13 as unpatentable over Elkin et al. (US 2007/0179828) in view of official notice is **not withdrawn** in light of applicant's arguments. Those arguments relating to new subject matter are left to the § 103 rejection below.

Applicant argues that the examiner's official notice do not teach the "checking-out" and "modifying" elements "as amended." However, applicant did not amend these elements. The examiner assumes therefore that the "amendment" is that the earlier "executing" step has been modified, therefore changing the underlying data upon which the "checking-out" and "modifying" elements act. However, as shown by the references provided, these elements are old and well known acts, irrespective of the context. For example, if the node were representative of one type of data or another does not change the fact that checking it out and modifying it are old and well known. The context doesn't affect the fact that the underlying actions are known, and still behave according to their well known and predictable behaviors. To overturn a prima facie case of obviousness, applicant needs to show an explicit demonstration of unexpected results or other secondary considerations.

7. The Examiner would like to note the requirements for traversing official notice from MPEP § 2144.03:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate [emphasis added].

Because Applicant has not specifically pointed out any errors in the Examiner's action, the officially noticed facts in the September 2, 2008 Office Action are deemed admitted prior art.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 7-10, 12, and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims clearly do not transform underlying subject matter. Further, the claims are not tied to another statutory class because the steps recited do not require a particular apparatus (e.g. a particular computer). A particular computer, as opposed to a general purpose computer, requires an explicit showing of the specific algorithms or methods that would serve to transform a generic computer capable of performing the algorithms to a computer that performs the algorithms. Applicant provides no evidence of the particular algorithm or method necessary to transform the generically claimed computer into a particular computer. The computer recited in the claims could be any computer, is non-limiting, and therefore is not meaningful. For these reasons, the claims are non-statutory.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 7-10, 12, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

**Claim 7:**

Applicant has added two new limitations that do not find support in the specifications and amount to new matter. First, the specification does not provide support for an enterprise planning session to be executed by a computer. Not only is this session not described as being performed by a computer, but there is no description of the steps a computer would take to undergo a planning session. Applicant has not pointed out where this newly added limitation finds support.

Second, the specification does not provide a written description of the process of "automat[ing] reconciliation." No evidence is provided of a computer program that would perform such a complex task. Applicant has not pointed out where this newly added limitation finds support.

Further claims are rejected for having the same or similar deficiencies via dependency.

**Claims 10, 12 and 13:**

The claims recite "reconciling" and "defining reconciliation jobs." However, there is no sufficient written description of this reconciliation process. At ¶ 51, "users ... are given the opportunity to reconcile." This does not describe the claimed method of reconciling. At ¶ 52, the specification merely states that reconciliation is done; no steps or description of a methodology used is given. For example, "servers 26 may be used to reconcile," "authentication servers 44 may 'push' reconciliation jobs," "the remote computing devices reconcile the contribution data," and so forth. None of these sections actually describe "reconciliation." Instead they just happen to mention the



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word. "Reconciliation" could mean anything, and one of ordinary skill in the art would not be conveyed of any form of "reconciliation."

Because "reconcile" is not a concept referring to some definite, well-known process, some instruction is expected to provide support of a method that reconciles. The mere naming of a function does not convey possession of that function. Evidence of the possession of that function is required. Without evidence of an actual process of reconciling (such as steps or a flowchart), one of ordinary skill in the art would not believe applicant was in possession of such an invention.

The Examiner can find no further support for this limitation. No person of ordinary skill would know the Applicant was in possession of a method for reconciling the data after check-out because no description relating to the matter is provided.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 7-10, 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 7:**

The "enterprise planning session" is claimed to "receiv[e] data." However, the session is not an entity capable of receiving data. The session, under the broadest reasonable interpretation, is an event. It is unclear if applicant meant the computer to receive that data.

The claim recites "automates reconciliation" but it is not clear what this process is. See the discussion below regarding "reconciling."

Further claims are rejected for having the same or similar deficiencies via dependency.

**Claims 10, 12, and 13:**

The scope of the "reconciling" is not clear. Applicant has provided no example methodology by which the reconciling is to occur, nor what the result is. Applicant cites ¶¶ 31 and 52, but neither of these paragraphs define reconciliation or describe what reconciliation is. Paragraph 32 does not define reconciliation or describe what reconciliation is. Instead, it uses the word "reconciliation" in a sentence without any meaningful description of what reconciliation is. Not only does the claim not provide meaning to the term "reconciling," but the specification is equally deficient in describing the term. The Examiner will not guess as to the intended meaning of this language because such a guess would be merely speculative in nature.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**16. Claims 7-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elkin et al. (U.S. 2007/0179828) in view of Examiner's Official Notice.**

**Claim 7:** Elkin discloses a system comprising:

Executing, by a computer, an enterprise planning session in accordance with an enterprise planning model, wherein the enterprise planning model defines hierarchically arranged nodes associated with business logic software modules and enterprise contributors, wherein the enterprise planning session receives data provided by the enterprise contributors and automates reconciliation of the data across an enterprise that corresponds to the enterprise planning model, and wherein the enterprise planning model comprises a financial model (see ¶¶ 13, 15, 40, Fig. 3, Fig. 7, noting an enterprise model application allows users to define enterprise models in a hierarchical fashion, for example a mortgage financial model);

Checking-out an individual model for editing during execution of the enterprise planning session in accordance with the enterprise planning model (see Table 1 - list of operations, including checkout and check in); and

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Modifying a model without preventing execution of the enterprise planning session for the model (see ¶ 13, noting users may edit the enterprise model without affecting current enterprise operations).

But Elkin fails to explicitly disclose, and the Examiner previously took Official Notice that it is old and well known to:

- Modify individual nodes of the model (Heinl, § 2.2, noting that flexibility by adaption is where a node is modified to include additional paths to other nodes; Halliday at 7, noting that tasks are individual nodes of a workflow and can be edited in a dynamic reconfiguration).
- Modify the nodes of the model without preventing execution of the session for the nodes that are not checked out (e.g., execute the enterprise planning session in accordance with the model while the modifications are occurring [i.e. dynamic modification/reconfiguration]). (Heinl at 80, first column, noting that modifications to the workflow occur in real-time, that is, while the model is still running; Halliday § 2.3 - Flexibility by adaptation: Dynamic Reconfiguration, noting tasks are modified).
- Check out individual nodes (e.g., that the administration console allows an analyst to check-out individual nodes of the model for editing during execution of the enterprise planning session without taking the model offline). (Heinl, Fig. 6, noting the lock / check out policy of one node at a time A or B; § 4.2.3, noting the use of check-in / check-out).

It would have been obvious to a person having ordinary skill in the art at the time of invention to modify the system in Elkin to include the dynamic modification features well known in the art, such as check-out of individual nodes and real-time modification. These well-known features are a known improvement to workflow systems like Elkin, and would provide the predictable result of allowing the system to be flexible as situations change.

**Claim 8:** Elkin discloses the system of claim 1, receiving updated model information for a node, and updating a respective slice of the enterprise planning model for only the node based on the updated model information (see ¶¶ 146 and 196, noting an updated process model may be overlaid on the existing process model in real-time).

Elkin fails to explicitly disclose that the nodes are checked-out. However, as shown in claim 7, node check-out is an old and well-known concept. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to specify that the updates to the model in Elkin are based on the nodes checked-out for updates, for the purpose of allowing changes to an existing model.

**Claim 9:** Elkin discloses the system of claim 2, wherein updating the enterprise planning model comprises modifying the business logic software module or the enterprise contributor associated with the checked-out node in response to the updated model information (see ¶¶ 196-198).

Elkin fails to explicitly disclose that the nodes are checked-out. However, as shown in claim 7, node check-out is an old and well-known concept. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to

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specify that the updates to the model in Elkin are based on the nodes checked-out for updates, for the purpose of allowing changes to an existing model.

**Claims 10, 12, and 13:** These claims do not specifically point out and distinctly claim the subject matter that the Applicant regards as his invention. The Examiner will not give speculative prior art rejections.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM V. SAINDON** whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623